

REMARKS

Claims 1-2, 12-14, and 45-51 are pending. Claims 45-51 are new. Claims 1, 12, and 14 have been amended. Claims 3, 5, 16, 41, and 44 have been cancelled. All cancelled subject matter has been cancelled without prejudice to its assertion in a continuing application.

Claim 1 has been amended by limiting the method to treating a human having a DNA methyltransferase mediated, bacterium induced disease, the method comprising administering a pharmaceutical composition comprising borinate based compounds. The four specific bacterium species were also removed from claim 1.

Claim 12 has been amended by making it depend from claim 1.

New claims 45-51 further limit the borinate compounds claimed in claim 1. Applicants note that the limitations of claims 45-51 were previously allowed in Europe, and issued in European Patent No. 1339725.

Typographical and usage errors in the claims were also corrected. Specifically, “azaperhydropinyl” was replaced with “azepanyl;” “oxazaperhydropinyl” was replaced with “oxazaepanyl;” one occurrence of “oxazaperhydropinyl,” which appeared twice was removed; and “oxadiazaperhydropinyl” was replaced with “oxadiazaepanyl.” One of ordinary skill in the art would readily appreciate the existence of these minor errors.

No new matter has been added by the above amendments.

Rejection of Claims 1-3 under 35 U.S.C. § 101

Claims 1-3 stand rejected under 35 U.S.C. § 101, for allegedly being directed to non-patentable subject matter. In light of the amendments to claim 1, Applicants submit that this rejection is now moot. Reconsideration and withdrawal is therefore respectfully requested.

Rejection of claims 1-3, 12-14, and 41 under 35 U.S.C. § 112, First Paragraph

Claims 1-3, 5, 12-14, 16, and 41 and 44 stand rejected for allegedly failing to comply with the written description requirement. Applicants respectfully disagree. The application discloses biological data that demonstrates inhibition of bacterial cell growth via inhibition of DNA methyltransferase. See, for example, pages 35, 92-94, and 122-124 of the application as

filed. Applicants submit that this data supports the claimed methods, and as a result, they request reconsideration and withdrawal of this rejection.

Rejection of claims 1-3, 12-14, and 41 under 35 U.S.C. § 112, Second Paragraph

Claim 1 stands rejected for allegedly omitting essential steps. In light of the amendments to claim 1, Applicants submit that this rejection is now moot.

Claims 3 and 5 have been cancelled, rendering these rejections moot.

Claim 12 stands rejected for allegedly not disclosing a therapeutically effective dose. Applicants submit that determining a therapeutically effective dose is within the skill of a person having ordinary skill in the art. Applicants further note that pages 50-52 of the application as filed, where determining the proper dosage is described. As described above, and contrary to the Office's position, inhibitors are described in the specification.

Claims 13 and 14 stand rejected for allegedly containing a non-sequitur. In response, Applicants have amended claim 12 by requiring the "methyl transferase inhibitor" to be a "DNA methyl transferase inhibitor." Applicants also amended claim 14 by requiring the DNA methyltransferase inhibitor to inhibit DNA methyltransferase enzyme activity.

Claim 16 has been cancelled.

In light of the above arguments and amendments, reconsideration and withdrawal of the rejections based on 35 U.S.C. § 112, Second Paragraph is respectfully requested.

Non-statutory Double Patenting Rejection and Rejections Based on 35 U.S.C. § 103

The claims stand rejected for allegedly improperly extending the right to exclude and for allegedly being obvious. Applicants submit that in light of the amendments to the claims, these rejections are now moot, and they request reconsideration and withdrawal of these rejections.

Related Applications

In compliance with the duty of candor owed to the Patent Office, Applicants note that they filed several DNA methyl transferase applications in the U.S., which include the following:
09/269137, now U.S. 6,413,751;
09/578991, filed 25 May 2000 (now abandoned);
09/996420, filed 29 November 2001 (now abandoned);

10/615703, filed 9 July 2003 (currently pending);
10/877729, filed 25 June 2004 (currently pending); and
11/929110, filed 30 October 2007 (currently pending).

CONCLUSION

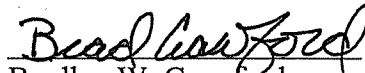
Entry of the claim amendments, allowance of the claims and passage of the case to issue are respectfully solicited.

The Applicants urge the Examiner to contact the Applicants' undersigned representative at (312) 913-2114, if the Examiner believes that a discussion would expedite prosecution of this application.

Respectfully submitted,

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By:


Bradley W. Crawford
Reg. No. 50,494

Telephone: 312-913-0001
Facsimile: 312-913-0002

**McDonnell Boehnen
Hulbert & Berghoff LLP**
300 South Wacker Drive
Chicago, IL 60606